

REMARKS/ARGUMENTS

The Examiner's Answer dated December 9, 2008 provides new grounds for rejecting pending claims 16-32 under 35 U.S.C. § 101. Aside from this, the Examiner's Answer restates the prior rejections of claims 21-32 under 35 U.S.C. § 112, the prior rejections of claims 16-18 under 35 U.S.C. § 102(e) under U.S. Patent 6,567,784 ("Bukow"), and the prior rejections of claims 19 and 21-32 as being obvious over Bukow in view of www.medquist.com ("Medquist").

Applicants have amended independent claims 16, 19, and 21 to overcome the rejection under 35 U.S.C. § 101. Further, Applicants have amended claim 17 to clarify its scope. However, with respect to the rejections under 35 U.S.C. § 112, § 102(e), and § 103(a), it appears that the arguments stated in the Reply Brief dated January 7, 2008 have not been considered by the Examiner. Applicants reiterate these arguments regarding the rejections under 35 U.S.C. § 112, § 102(e), and § 103(a) in this response so that they may be fully considered by the Examiner.

New Grounds of Rejection – 35 U.S.C. § 101

The Answer dated December 9, 2008 asserts new grounds under 35 U.S.C. § 101 for rejecting pending claims 16-32. The Answer states that claims 16-32 "are rejected under 35 U.S.C. §101 because the claims do not limit any process step to any specific machine/apparatus or transformation of an article." (Answer, p. 3). The Answer asserts that the machine-transformation test requires an applicant to show that a process claim satisfies § 101 by (1) showing that this claim is tied to a particular machine or (2) showing that the claimed process transforms an article.

Applicants have herein amended independent claims 16, 19 and 21 and respectfully submit that the claims as amended are statutory material under 35 U.S.C. § 101. Claim 16 has been amended to require, in part, "electronically providing to a pool of potential applicants a notification of a need to produce at least one type of atomic unit of work, wherein the work is capable of being transmitted electronically over the Internet to an employer computer system." Further, claim 19 has been amended to require *inter alia*, "receiving the work product for each performed atomic unit of work over the Internet at an

employer computer system.” In addition, claim 21 has been amended to require *inter alia*, “receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet at an employer computer system.” Thus, each of the amended claims is tied to a particular machine, namely a computer system that receives work product or an atomic unit of work.

Further, receiving or transmitting work electronically over the Internet to a computer system is not insignificant extra solution activity, but rather an important aspect of the invention. Indeed, the system is not capable of functioning without this feature. The pending application describes this significant aspect of the invention throughout the specification. Generally, the claimed invention includes methods that relate to a nonconventional employment model called an Extended Work Program (EWP). (¶¶ [0001]-[0002]). EWP uses the Internet to identify, employ, manage, and compensate workers in a distributed computer environment (*Id.*; FIG. 1). Further, EWP allows workers the freedom to choose their work locations. (¶¶ [0002]-[0003]). Hence, an employer and a worker are residing in geographically dispersed locations. This allows the employer to select from a large pool of workers with different levels of professional experience and assign work that matches a worker’s experience level. Otherwise, if an employer is limited to hire from a pool of local workers, the employer may not be able to find a suitable candidate for a specific task.

FIG. 1 and its associated description discuss aspects of the invention that facilitate communication between an employer computer system and a worker computer system, across the Internet, wherein each computer system resides in a different location. (¶¶ [0024]-[0027]). This feature of the invention allows an employer to assign tasks to a worker and a worker to deliver the subsequent completed tasks. Otherwise, the employer would not be able to hire a worker residing in a geographically dispersed location and would limit the size of the pool of workers available to the employer. Assigning and completing work as well as selecting a worker with suitable experience for a particular task are significant aspects of the invention.

Thus, the amended claims are tied to a particular machine, namely to a computer system. Moreover, for the reasons set forth above, the involvement of a computer system in the claimed methods is a significant aspect of the invention. Therefore, the amended

independent claims 16, 19, and 21 claim patentable subject matter under 35 U.S.C. § 101 and thus Applicants respectfully request favorable reconsideration of the rejections under § 101.

Further, with respect to claims 17, 18, 22-32, all of which depend directly or indirectly from one of claims 16 and 21, it is respectfully submitted that such dependent claims are statutory and patentable for at least the same reasons as claims 16 and 21 respectively.

Rejection of Claims 21-32 under 35 U.S.C. § 112

The Answer notes that “claim limitations” may not be “narrower than” the specification – however, this is a very misleading statement, and is false in the context in which it was used. It is beyond question that an inventor may claim an invention that is “narrower” than the embodiments described in the specification. *See Lampi Corp. v. American Power Products, Inc.*, 228 F.3d 1365, 1378, 56 USPQ2d 1445, 1455 (Fed. Cir. 2000) (“[i]t is a familiar principle of patent law that a claim need not be limited to a preferred embodiment.”) Indeed, dependent claims by their very nature are “narrower” than the claims from which they depend, which in turn must be supported by the specification. Likewise, an inventor who describes a genus and a species in the patent specification may present claims to the broader “genus” and to the “narrower” species.

The specific rejection at issue is that “Applicant fails to disclose a contractor as a candidate therefore leaving the claim limitations narrower than that of the specification.” (Answer. p. 4.) Applicants, however, identified by page and paragraph the specification’s description of how participants in the Employee Work Program (“EWP”) choose their own hours, locations, types of work and even employers. (Appeal Br. at 5.) By definition, such participants would indeed be considered independent contractors. (*Id.*) Moreover, the specification describes a new employment system and method to address the problem of unemployed and underemployed workers. It should be readily apparent to those of skill in the art that the participants are not conventional employees.

Importantly, the Answer concedes that the term “independent contractor” has a known meaning. (Answer, p. 7-8.) It also concedes that the specification describes EWP participants as meeting the requirements for appropriate characterization as “independent

contractors.” (*Id.*, p. 8.) These concessions should establish beyond dispute that the specification adequately describes a method involving independent contractors.

It is noted with regret that the Answer misstates the law regarding the written description requirement. In particular, the Answer erroneously contends “*The applicant has the burden of showing* that a person of skill in the art would have understood, at the time the application was filed *that the description requires the limitation.*” (Answer, p. 8 (emphasis added)). Nothing in the case cited by the Answer (*Hyatt v. Boone*), establishes such a requirement. Indeed, the law is exactly the opposite.

The Federal Circuit actually places the burden on the *Examiner* to establish the lack of written description. See *In re Alton*, 76 F.3d 1168, 37 U.S.P.Q.2d 1578, 1583-4 (Fed. Cir. 1996). Where, as here, “the specification contains a description of the claimed invention, albeit not *in ipsius verbis* (in the identical words), ***then the examiner or Board***...must provide reasons why one of ordinary skill in the art would not consider the description sufficient.” *Id.* (emphasis added). In the present case, the Examiner has not offered any evidence or reasoning to meet the Office’s burden.

Moreover, the test is not whether “the description requires the limitation” as argued in the Answer. Instead, the Federal Circuit has instructed that an applicant must only convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in “possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q. 2d 1111, 1117 (Fed. Cir. 1991). The Court further has cautioned that “[t]he disclosure as originally filed does not... have to provide *in haec verba* support for the claimed subject matter at issue.” *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1364, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). The appropriate test, therefore, is whether the Applicants’ specification demonstrated possession of the invention as involving independent contractors as participants.

To answer this question, Applicants’ Appeal Brief pointed to the support in the specification for this exact claimed feature. The fact that broader subject matter is also described does not mean that the Applicants must expand their claims to cover all such embodiments. The specification describes methods and systems in which participants in an

EWP are independent individual contractors, and Applicants have the right to claim such embodiments.

Under the correct legal analysis, the rejection of claims 21-32 for lack of written description under 35 U.S.C. § 112 should be reconsidered and withdrawn.

Rejection of Claims 16-18 under 35 U.S.C. § 102(e)

The Answer argues that rejected claims 16-18 are anticipated by Bukow. Bukow, however, manifestly does not describe the step of “determining several types of atomic units of work needed to perform a task.”

The Answer does not fairly meet Applicants’ argument. In response to Applicants’ arguments, the Examiner offers the possibility that Bukow’s website artwork may be an atomic unit of work that is part of a larger task. Even if this argument is credited, Bukow does not describe the step of determining *several* types of atomic units. The hypothesized website may or may not include work in addition to “artwork” that a business would subdivide. Bukow is simply silent on the point. Bukow further fails to describe at all the concept of “several types” of atomic units of work needed to perform a task. As noted in Applicants’ Appeal Brief, even if the “artwork” could be considered an atomic unit of work, Bukow does not describe the step of determining different “types” of atomic units of work needed to perform a task.

The Answer attempts to sidestep this problem by arguing that “the proceeding steps simply require ‘at least one’ type of atomic unit to be performed.” (Answer, p. 9.) Although this is correct, claim 16 nevertheless still requires the step of *determining several* types of atomic works. Because Bukow does not describe this step, expressly or inherently, it cannot possibly anticipate claim 16.

The Answer also avoids joining issue on claim 18. This claim requires “an indirect message delivery process,” which is an announcement made only to selected qualified prospective participants, who may accept the opportunity and/or pass the opportunity to other prospective candidates. (See Specification, pp. 13-14, ¶ [0051].) The “indirect” message delivery process is differentiated from a “direct” message process. In the indirect process, which is claimed, only a select group of previously qualified participants receive notice. (*Id.*) In the direct process, all previously qualified participants receive notice. (*Id.*) Bukow arguably

discloses a “direct” message process, which the Examiner notes at page 9 of the Answer, but it does not disclose the “indirect” process.

For the foregoing reasons, Bukow does not describe the subject matter of claims 16-18. The Answer's rejection of these claims as being anticipated by Bukow should be reconsidered and withdrawn.

Rejection of Claims 19 and 21-32 under 35 U.S.C. § 103(a)

Applicants again respectfully request reconsideration of the rejections of claims 19 and 21-32 under §103. Applicants incorporate by reference, but do not repeat herein, their arguments regarding the lack of any teaching, suggestion or motivation to combine the Bukow reference with the Medquist reference.

Applicants further stand by their prior arguments that Bukow does not describe the actual claim limitations. This reference does not disclose the steps of “separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers” and then “determining the type of atomic units of work needed to perform the subparts” (Claim 19) and “offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work” (Claim 21). Even if the Examiner's argument (at page 10) regarding Bukow's description of website artwork is credited, Bukow manifestly does not describe the step of determining *several* types of atomic units.

In addition, neither Bukow nor Medquist describes the step in claim 21 of “receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet.” The Examiner's Answer (at p. 6) concedes that Bukow does not describe this limitation, but it then cites to a section of Medquist (p. 18, ¶ B) that describes a *client's* use of the Internet. This portion of Medquist does not describe in any way the activities of the person who actually performed the work. As such, the Examiner has failed to establish a *prima facie* case of obviousness even assuming that the hypothetical combination of Bukow/Medquist is proper.

In addition, the hypothetical combination of Bukow/Medquist simply does not teach the steps set forth in claims 22-32. Among other things, Medquist describes a medical

coding operation; it does not describe a work process for reviewing a document for typographical errors (claim 22) or transcription (claim 23) for a certain duration (claim 24). It also does not describe a work process for insurance claims (claims 25, 26) or processing accounts payable (claim 27). Likewise, neither Bukow nor Medquist addresses the qualifications of participants as measured by English language skills (claim 28), a high school diploma (claim 29), or completion of a specialized training program tailored to the specific atomic unit of work (claim 30). Finally, there is nothing in either reference that screens candidates based on prior experience in conducting the particular type of atomic units of work (claims 31, 32). The rejections involving these claims should be reconsidered and withdrawn due to the absence of a *prima facie* case of obviousness.

Conclusion

In summary, the invention as set forth in the rejected claims is patentable subject matter, has adequate written description support in the specification and, further, is not anticipated or rendered obvious by the combined teachings of Bukow and Medquist. For these reasons, as well as others stated hereinabove, the presently pending claims are patentable over the prior art presently known to Applicants.

Applicants therefore request favorable reconsideration of claims 16-19 and 21-32 and submit that the patent application is in condition for allowance. If a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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